

*7/ Petition
to Suspend*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

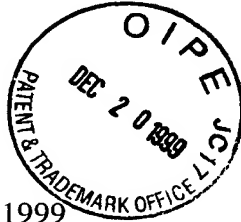
In re Patent Application of

HENSHAW

Appln. No. 09/393,261

Filing Date: September 10, 1999

FOR: RODENTICIDE



Art Unit: Not Assigned

Examiner: Not Assigned

*Be
2-16-00*

* * *

December 20, 1999

PETITION TO SUSPEND ACTION UNDER 37 CFR 1.103(a)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant petitions the Commissioner to suspend action in the present continuation application under 37 CFR 1.103(a) until a final decision has been made on the Petition filed under 37 CFR 1.137(b) to revive the unintentionally abandoned international application PCT/GB97/00800 designating the U.S. (published as WO 97/35470 on October 7, 1997). The aforementioned Petition to revive the parent application is being made to establish copendency with this continuation application. Unless the Petition to revive is granted, this continuation application will not be able to claim an effective filing date prior to the publication date of WO 97/35470 and Applicant's invention as disclosed in that international application would be considered prior art. Thus, in the interest of justice, Applicant requests suspension of action in the present application by the U.S. Patent and Trademark Office (USPTO) until a final decision has been rendered on the aforementioned Petition to revive under 37 CFR 1.137(b) or, in the alternative, for a period of at least six months until June 20, 2000, based on the following showing of good and sufficient reasons.

The parent application is PCT/GB97/00800 designating the U.S. The parent application went abandoned for failure to enter the national stage or to file a continuation application in the USPTO. As discussed in the Petition filed under 37 CFR 1.137(b), this delay to respond by filing a continuation application was unintentional. If the Petition to revive the parent application is denied, the effective filing date of the present application would be September 10, 1999 and WO 97/35470 publication would be considered anticipatory prior art under 35 U.S.C. 102(b). Alternatively, if the Petition to revive the parent application is granted, Applicant's own disclosure would not be considered prior art because the present application's effective filing date would be prior to the publication date of WO 97/25470. Clearly, the future course of prosecution is completely dependent on a final decision on the Petition to revive the parent application PCT/GB97/00800.

This application was filed under 37 CFR 1.53(b)(1) on September 10, 1999 and an Office Action has not yet been received. A Notice to file missing parts was received on September 29, 1999. In response, a declaration/power of attorney and an assignment were filed November 29, 1999. A Notice of incomplete response was received on December 3, 1999 but this was inappropriate for the reasons explained in the response filed December 9, 1999. A small entity claim and refund request was submitted on November 10, 1999 but a refund has not yet been received.

No reply by Applicant to an Office Action is required at this time. A decision on the Petition to revive has not been received.

Applicant's intention is to place the present application in the best posture for examination by the USPTO. Examining the present application prior to a final decision on the Petition to revive the parent application would be a waste of resources because claims could

HENSHAW – Appln. No. 09/393,261

not be deemed allowable until an effective filing date prior to October 7, 1998 (i.e., the statutory bar date under 35 U.S.C. 102), was established. Otherwise, examination in the USPTO would have to consider prior art with an effective filing date of March 27, 1996 (i.e., the filing date of the priority document), March 21, 1997 (i.e., the filing date of the international application), or September 10, 1999 (i.e., the filing date of the present application) to ensure compact prosecution. Therefore, it is respectfully requested that action in the present application be suspended until a final decision has been rendered on the aforementioned Petition to revive under 37 CFR 1.137(b) or, in the alternative, for a period of at least six months until June 20, 2000.

The fee as required by 37 CFR 1.17(i) is enclosed herewith. If this fee is missing or insufficient, the Patent Office is hereby authorized to charge our Deposit Account No. 03-3975, Order No. 81816/254839 for the missing or insufficient amount, for which purpose a duplicate copy of this paper is attached.

Favorable consideration of this petition is earnestly requested. The Patent Office is invited to contact the undersigned if further information is needed.

Respectfully submitted,

Cushman Darby & Cushman
Intellectual Property Group of
PILLSBURY MADISON & SUTRO, L.L.P.

By *Paul N. Kokulis* Reg. No. 43,180
for Paul N. Kokulis
Reg. No. 16,773
(202) 861-3503 telephone
(202) 822-0944 facsimile

PNK/GRT:maf
1100 New York Avenue, N.W.
Ninth Floor, East Tower
Washington, D.C. 20005-3918